

## REMARKS

Claims 1 through 3 and 6 through 18 are pending in this application, of which claims 8 through 17 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Accordingly, claims 1 through 3, 6, 7 and 18 are active.

Claims 1 and 6 have been amended, claims 4 and 5 cancelled and claim 18 added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, as, for example, the depicted embodiments and related discussion thereof in the written description of the specification as well original claims 2, 4 and 5. Applicants submit that the present Amendment does not generate any new matter issue.

### **Objection to the Disclosure**

The Examiner objected to the disclosure identifying a manifest typographical oversight on page 14. In response, the specification has been amended consistent with the Examiner's observation, thereby overcoming the objection to the disclosure.

**Claims 1 through 7 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Akram.**

In the statement of the rejection, the Examiner referred to Fig. 16, asserting the disclosure of a semiconductor device comprising a trench isolation 1602 corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that

the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Elan Pharmaceuticals Inc. v. Mayo Foundation*, \_\_\_\_ F.3d \_\_\_\_, 64 USPQ2d 1292 (Fed. Cir. 2002); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the claimed inventions and the semiconductor device disclosed by Akram that scotches the factual determination that Akram describes a semiconductor device identically corresponding to that claimed.

Specifically, it is not apparent wherein Akram discloses a semiconductor device having a structure corresponding to that defined in independent claim 1, particularly "a substantially inclined third side surface connecting said first side surface and said second side surface with each other". In this respect, Applicants would refer to Figs. 9 and 12 and the related discussion thereof in the written description of the specification, notably at page 21, lines 1 et seq. The inclined third side surfaces are functionally significant in preventing defective embedding in the trench.

The above argued functionally significant difference between the claimed semiconductor device and the semiconductor device disclosed by Akram undermines the factual determination that Akram discloses a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 7 under 35 U.S.C. § 102 for lack of novelty as evidenced by Akram is not factually viable and, hence, solicit withdrawal thereof.

09/985,743

**New Claim 18**

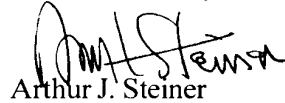
Akram neither discloses nor suggests a semiconductor device having a trench structure as defined in claim 18, which trench structure has a third side surface which is S-shaped.

It should, therefore, be apparent that the objection to the disclosure and the imposed rejection have been overcome, and that all active claims are in condition for immediate allowance. Favorable consideration is therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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